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09/937,408	09/24/2001	Akinori Tokinaga	3882-011607	9496

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EXAMINER

PATEL, KIRAN B

ART UNIT

PAPER NUMBER

3612

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Please find below and/or attached an Office communication concerning this application or proceeding.

2-2



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/937,408
Filing Date: September 24, 2001
Appellant(s): TOKINAGA ET AL.

Russell D. Orkin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/22/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 5-10 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,238,286	Tanaka et al.	8/1993
5,037,130	Okuyama	8/1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. '286.

Regarding Claims 5-10, Tanaka et al. '286 discloses in Fig. 1-4 the invention as claimed to include a main body constituted by a pipe 1 (known in the art with broad range of E and I), a steering bracket 4, a bracket 12, a U shaped stay 2, a reinforcing member 9, 10.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production (crush-molding). (MPEP 2113).

(11) Response to Argument

The Appellant's recitation "the cited prior art reference fails to meet each and every structural limitations of the claims as discussed hereinafter" is incorrect and Appellant's argument fails to make a persuasive argument.

Appellant's argument "the term "crush-molding" is not a product-by-process limitation as indicated by the Examiner. Rather, "crush-molding" as set forth in claim 5 is a physical, structural limitation that is in no way taught or suggested by the Tanaka patent" is not a valid argument because the specification page 6, lines 6-9, "Crush-molding is performed on both ends of this pipe, and the crush-molded parts 1a and 1b are used as connecting parts that are connected to the front pillars" clearly and accurately indicate that the parts 1a and 1b are made by "crush-molding" process. Also the meaning of crush in the dictionary is - the act of

Art Unit: 3612

crushing; extreme pressure and the meaning of molding in the dictionary is - something that is molded.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., supporting rigidity, eliminates the need for the additional components (11,10), etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant's arguments regarding to the only independent claim 5 has been fully responded to by the Examiner. Appellant's arguments regarding claims 6-10 have not been responded to by the Examiner because claims 5 is the only independent claim in the Grouping of Claims 5-10 and most of the matter argued relating to claims 6-10 is not recited in the rejected claim(s).

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 3612

Respectfully submitted,

KB Patel

Kiran B. Patel

Primary Examiner

Art Unit 3612

KBP

June 17, 2003

Conferees

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